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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,102	02/12/2002	Satoshi Suzuki	X2007.0093/P093	3701

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EXAMINER

FONTAINE, MONICA A

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/073,102

Applicant(s)

SUZUKI ET AL.

Examiner

Monica A Fontaine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 021202,012103.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the injected synthetic resin" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as containing an improper alternative limitation. According to MPEP § 2173.05 (h), alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. A Markush group is an acceptable form of alternative expression and must contain the phrase "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). Claim 9 contains the incorrect alternative expression "at least one material selected from metal, resin, and inorganic material". In order to correct the claim, the

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examiner suggests rewording the claim as follows: "at least one material selected from the group consisting of metal, resin, and inorganic material".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-6, and 8-9 rejected under 35 U.S.C. 102(b) as being anticipated by Wilkinson (U.S. Patent 3,844,030). Regarding Claim 1, Wilkinson shows that it is known to carry out a method of manufacturing a composite molded product (Abstract), comprising the steps of coating an insert material with dope cement (Column 2, lines 45-61), and subjecting the insert material coated with dope cement to insert molding (Column 3, lines 4-10).

Regarding Claim 3, Wilkinson shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the dope cement is obtained by dissolving a synthetic resin in a solvent, where the synthetic resin is injected synthetic resin in the insert molding or synthetic resin which has compatibility with the injected synthetic resin (Column 4, lines 42-63).

Regarding Claim 5, Wilkinson shows that it is known to carry out a method of manufacturing a composite product (Abstract), comprising the steps of applying a solution, which comprises a first synthetic resin and a solvent, over a substrate to form a first layer

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comprising the synthetic resin (Column 2, lines 45-61), and forming a second layer, which comprises a second synthetic resin compatible with said first synthetic resin, on said first layer (Column 3, lines 4-10).

Regarding Claim 6, Wilkinson shows the process as claimed as discussed in the rejection of Claim 5 above, including a method further comprising removing said solvent to form said first layer over said substrate (Column 2, lines 64-68).

Regarding Claim 8, Wilkinson shows the process as claimed as discussed in the rejection of Claim 5 above, including a method wherein said second layer is formed on said first layer by injection molding (Column 3, lines 4-10).

Regarding Claim 9, Wilkinson shows the process as claimed as discussed in the rejection of Claim 5 above, including a method wherein said substrate is made from metal (Column 2, lines 46-50).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson, in view of Grootaert t al. (U.S. Patent 5,500,042).

Regarding Claim 2, Wilkinson shows that it is known to carry out a method of manufacturing a composite molded product (Abstract), comprising the steps of coating an insert

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material with dope cement (Column 2, lines 45-61), and subjecting the insert material coated with dope cement to insert molding (Column 3, lines 4-10). Wilkinson does not show an additional step of priming the insert material. Grootaert et al., hereafter "Grootaert," show that it is known to carry out a method wherein a substrate is primed prior to being coated and inserted into further molding operations (Column 4, lines 44-52; Column 5, lines 24-38). Grootaert and Wilkinson are combinable because they are concerned with a similar technical field, namely, that of insert molding processes. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to prime Wilkinson's insert material, as in Grootaert, in order to promote better adhesion between the insert material and the coating.

Regarding Claim 4, Wilkinson shows the process as claimed as discussed in the rejection of Claim 2 above, including a method wherein the dope cement is obtained by dissolving a synthetic resin in a solvent, where the synthetic resin is injected synthetic resin in the insert molding or synthetic resin which has compatibility with the injected synthetic resin (Column 4, lines 42-63), meeting applicant's claim.

Regarding Claim 7, Wilkinson shows the process as claimed as discussed in the rejection of Claim 5 above, but does not show an additional step of priming the insert material. Grootaert shows that it is known to carry out a method wherein a substrate is primed prior to being coated and inserted into further molding operations (Column 4, lines 44-52; Column 5, lines 24-38). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to prime Wilkinson's insert material, as in Grootaert, in order to promote better adhesion between the insert material and the coating.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to insert molding in general:

U.S. Patent 5,998,034 to Marvil et al.

U.S. Patent 6,245,182 to Nakamura

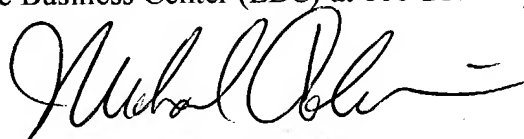
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A Fontaine whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maf  
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MICHAEL COLAIANNI  
PRIMARY EXAMINER